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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Pennington

Serial No.: 09/582,971 Art Unit: 1627

Filed: 07/07/2000 Examiner: Koroma, B.

For: USE OF MASS FINGERPRINTING FOR IDENTIFICATION OF PROTEIN AFFINITY LIGANDS

Docket No.: 60,319-010

Assistant Commissioner For Patents
Washington, D.C. 20231

REPLY TO RESTRICTION/ELECTION
REQUIREMENT UNDER 35 U.S.C. § 121

Dear Madam:

This paper is responsive to the Office Action mailed March 27, 2001.

Applicant hereby elects, with traverse, the Invention of Group I (claims 1-11, and 17-30).

The requirement for an election of an Invention Group for prosecution on the merits is respectfully traversed. Examiner states the claims in the above-identified application relate to methods of use (Groups I, IV, V, and VI) and methods of making (Groups II and III). Applicant respectfully submits, however, that the Examiner has failed to demonstrate that the claimed Invention Groups are "distinct."

CERTIFICATE OF MAILING

I hereby certify that the enclosed Reply to Restriction/Election Requirement Under 35 U.S.C. § 121 is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on this 27th day of June, 2001.

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As set forth in MPEP § 803, a restriction is proper where an application includes claimed inventions that are either "independent" or "distinct" from one another. The Examiner has asserted that "[T]he inventions are distinct" (emphasis added).

Examiner asserts Groups I, IV, V, and VI are related as patentably distinct methods of use. Examiner suggests Group I is distinct from Group V because it "may . . . necessitate a different experimental approach from that of Group V" because the selection involved with Group I "may involve" a large number of molecules, in contrast to selection "to an affinity to a protein of interest." Examiner suggests Group IV is distinct because it involves a process of secondary selection in contrast to an initial screening. Examiner suggests Group VI is distinct, dependent only on the nature of a protein affinity ligand because the ligand may require special methods not otherwise applied. Applicant respectfully suggests that these conditional statements, which may not apply, do not meet the necessary showing that the related Invention Groups are indeed patentably "distinct".

Examiner asserts Groups II and III are related as patentably distinct methods of making. Examiner suggests a method of making antibodies targeted to a plurality of proteins of Group II "may require a significantly different approach" than used in a method to make a library of such antibodies, as claimed in Group III. Applicant again respectfully suggests these conditional statements do not meet the burden necessary to show patentable "distinctiveness" of the Invention Groups.

Examiner asserts the methods of using (Groups I, IV, V, and VI) are related yet patentably distinct from the methods of making (Group II, III) because the methods involve different objectives, different steps, and are capable of utilizing different reagents. Applicant respectfully suggests that the above statement does not meet the necessary showing that Invention Groups require different biliographic searches or separate status in the art.

The present invention describes a high throughput method to produce and identify protein affinity ligands either to proteins of interest or proteins that may previously have been unidentified. Such protein affinity ligands comprise antibodies, polycolonal, monoclonal and any other molecule which could be applied to the present invention. The present invention can be used with one or a mixture of known/unknown proteins. For example, a mouse can be immunized with an antigen or a mixture of antigens and its spleen removed some time later. The spleen cells are then fused with immortal cells to form hydridoma. The antibodies produced by the hydridoma are immobilized and used to isolate the known/unknown proteins. Subsequently individual proteins can be eluted and characterized thereby according to the antibody, its identity/value. The method directly provides useful diagnostic tools and reagents for a wide variety of other applications.

The Examiner has the burden of showing that the restriction is proper. Applicant respectfully submits that the Examiner has failed to carry this burden because the Examiner has failed to show that the claims of Groups I, II, III, IV, V, and VI are all patentably distinct from one another. Accordingly, Applicant respectfully submits that the restriction requirement is improper and should be withdrawn.

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Petition for Extension/Deposit Account Authorization

Applicant believes a two month extension of time is required and hereby petitions for a two month extension of time under the provisions of 37 C.F.R. 1.136(a). The Assistant Commissioner is hereby authorized to charge Deposit Account No. 04-2223. If any additional extension and/or fee is required, the Assistant Commissioner is hereby authorized to charge Deposit Account No. 04-2223. Similarly any credit should be deposited in Deposit Account No. 04-2223.

Respectfully submitted,

Date: June 27, 2001

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